

Serial No. : 10/782,794  
Page : 2

Attorney Ref: 28967.0178  
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REMARKS

Claim 1 remains herein.

Applicant's claim 1 was rejected over

(1) European Plant Breeder's Right (PBR) application  
number 011850, published February 15, 2002;

in view of: (2) the admitted fact that the claimed plant variety, named  
"CETWOTONE PINK", was sold in the Netherlands (outside the  
United States) as early as August 2002; and  
(3) the Royal Horticultural Society (RHS) Dictionary of  
Gardening, 1992, vol. 1.

The European PBR application was published in 2002, and the claimed plant variety was sold in the Netherlands (outside the United States) in 2002, both more than 1 year before the filing date of the instant application. The RHS dictionary was cited as evidence merely that one of ordinary skill in the art would have known how to propagate chrysanthemums by various methods of asexual propagation.

The Office Action, page 4, asserts that: "a person of ordinary skill in the art could have contacted CBA [applicant's assignee] by phone or mail and checked the availability of the instant plant and/or where to purchase the plant." However, this statement ignores the facts submitted in applicant's "Reply to Requirement for Information Under 37 CFR 1.105" filed June 2, 2005, page 2, which expressly states

[A] breeder's reference [a number] is used in the PBR [application] papers during the initial phase of registration during the initial registration phase prior to the grant of a PBR title. The assignee never discloses information regarding varieties under registration to third parties regardless of how the plant is denominated in those initial papers. [emphasis added here]

Serial No. : 10/782,794  
Page : 3

Attorney's Docket No.: 28967.0178

These facts were restated in the Request for Reconsideration filed October 5, 2005. These are facts, not arguments, and were so represented to the PTO in written response to the Request for Information. These facts can not be ignored by PTO arguments that one skilled in the art "could have contacted CBA by phone or mail and checked the availability of the instant plant and/or where to purchase the plant." As expressly represented in response to the Request for Information in this application, the assignee does not disclose any such information, and thus this record does not show that such information was publicly available.

While the Office Action of April 3, 2007 cites nothing other than 35 U.S.C. §102(b) as alleged legal basis for the rejection, the prior Office Action of January 26, 2006, page 4, made passing reference to In re LeGrice, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). And, the earlier Office Action of December 17, 2004, pages 4 and 5, stated:

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. In re LeGrice, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See Ex parte Thomson, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.").

While the publication cited above discloses the claimed plant variety, a question remains as to whether the references are enabling. If the plant was publicly available, then the application, proposed denomination or granted PBR certificate, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant.

Serial No. : 10/782,794  
Page : 4

Attorney's Docket No.: 28967.0178

And, the subsequent Office Action of August 25, 2005, page 3, relied upon In re Elsner, 381 F.3d 1125, 72 USPQ2d 1038 (Fed. Cir. 2004).

Regardless of the particular wording of the rejection in the various Office Actions in this prosecution history, in essence, the rejection is based upon applicant's 2002 published PBR application as allegedly "enabled" by sale in late 2002 in the Netherlands, of the plant sought to be patented in the present application. But, the Office Actions all overreach at critical points.

In LeGrice, the CCPA held that 35 U.S.C. §161 plant patents are subject to §102(b) in the same manner as it was and is applied to other types of claimed subject matter. Importantly, the CCPA said that §102(b) and its predecessor statutes have been interpreted "as requiring that the description of the invention in the publication 'must be sufficient to put the public in possession of the invention.'" 301 F.2d at 933; emphasis added here; citing Seymour v. Osborne 11 Wall. 516, 555, 78 U.S. 516, 555 (1870). And, the CCPA said that the disclosure of a publication, to be a statutory bar under §102(b), "must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." id. at 936; emphasis in original; citing Cohn v. U.S. Corset Co., 93 U.S. 366 (18\_\_). The emphasis upon the cited publication being sufficient effectively to place one of skill in the relevant art in possession of the invention sought to be patented is repeated throughout LeGrice.

Thomson involved a regular utility patent application seeking to patent a cotton plant and seeds thereof. Two publications describing the claimed plant and seeds were admittedly, per se, not enabling, but were allegedly rendered enabling by foreign availability of the plant more than one year before Thomson's U.S. application filing date. The Board in Thomson did state, without citing any basis whatsoever, "The issue is not whether...[the claimed invention]...was on public use or sale in the United States, but rather whether ...[it]...was available to a skilled

Serial No. : 10/782,794  
Page : 5

Attorney's Docket No.: 28967.0178

artisan anywhere in the world such that he/she could obtain...and make/reproduce...[it as]...disclosed in the cited publications.” 24 USPQ2d at 1620. The Board in Thomson found it reasonable to conclude that at the time that the cited articles were published, skilled artisans “throughout the world” [apparently including those in the U.S.] would have found the relevant seeds readily available [again apparently in the U.S.] and “there is no evidence of record to the contrary.” *Id.* However, there is evidence to the contrary in the instant record.

In Elsner, the Federal Circuit found §161 plant patent applications to be different from regular utility applications claiming a non-plant subject matter. Although the court said:

Only when possession...enables a person of skill in the art to practice asexual reproduction of the plant in a manner consistent with the statute can a non-enabling publication and foreign sale act as a § 102(b) bar.

Elsner, 381 F3d at 1128-29, in fact the court found a possible bar in a manner inconsistent with the statute. In Elsner, the court found that because the published PBR application, combined with foreign sales of the plants, apparently placed the claimed inventions “in the possession of the public” that those publications demonstrated to have been enabled by the foreign sales “are proper §102(b) anticipatory references that may bar patentability.” *id.* at 1129; emphasis added here. But, the Federal Circuit in Elsner remanded to the PTO for further factual findings relating to the accessibility of the foreign sales and the reproducibility of the claimed plants from the plants sold. The relevant accessibility under §102(b) should be accessible in the United States.

In the present application, there is no evidence in this record that sales in the Netherlands any time more than one year before the filing date of the present application, in fact resulted in, or could have resulted in, possession in the United States of plant material “to practice asexual reproduction of the plant” as claimed herein in a manner consistent with the statute. See Elsner, 381 F. 3d at 1128-29. Accordingly, the alleged bases for alleged enablement by the disclosure of

Serial No. : 10/782,794  
Page : 6

Attorney's Docket No.: 28967.0178

applicant's published 2002 PBR application are missing key facts which render the alleged bases for the present rejection incomplete, and therefore render the rejection inapposite.

The references alleged to support the rejection here are facially deficient for several reasons:

1. The published PBR application document is admittedly not enabling of applicant's claimed plant variety in the absence of the plant material itself. In re LeGrice, 301 F.2d 929 (CCPA 1962).
  2. The plant "CETWOTONE PINK" was admittedly sold outside the United States, more than one year before this U.S. application was filed, but it was not sold or imported into the United States before applicant's U.S. filing date. Thus, there was no §102(b) public use or sale in the United States of the claimed plant. The foreign sales of the claimed plant are not de jure prior art under §102(b) (or any other paragraph of §102), or §103.
  3. No single cited reference among the published PBR application, the admitted foreign sale, or the RHS dictionary, was itself a complete, enabling, de jure prior art disclosure effective under §102(b) to bar patentability of applicant's claim. See 35 U.S.C. §102(b); In re LeGrice; but cf., In re Elsner, and Ex parte Thomson.
  4. There has been no showing by the PTO in this record of any evidence of anyone of even ordinary skill in the art who in the United States made and used applicant's claimed plant variety at any date more than one year before applicant's filing date. This record does not demonstrate that applicant's claimed plant (or any genetic material from which it could have been created) was ever present in the United States before the filing date of this U.S. application.
- §102(b) expressly identifies only matters "on sale in this country" as patent-barring acts. There is in this record no evidence of any such §102(b) "public use or on sale in this country" of

Serial No. : 10/782,794  
Page : 7

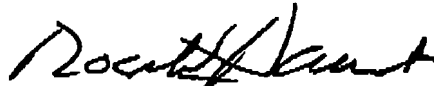
Attorney's Docket No.: 28967.0178

applicant's claimed invention, or even elements, predecessors or genetic sources thereof. While the CCPA in LeGrice said that 35 U.S.C. §161 expressly states that plant patent applications are "subject to other conditions and requirements" of Title 35 U.S. Code, including §102(b), in fact, the Board in Thomson, and the Federal Circuit in Elsner, treat §161 plant patent applications differently from patent applications claiming other subject matter. The statute itself must control. The statute §102(b) defines what is prior art under §102(b). And this record does not include any such patent-barring §102(b) prior art.

For all the foregoing reasons, reconsideration and withdrawal of this rejection, and allowance of applicant's claim 1 are respectfully requested.

This application is now believed to be fully in condition for allowance, which is respectfully requested. Should the Examiner believe that further changes to this application would put it in even better form for issue, the Examiner is invited to telephone applicant's undersigned attorney at the number listed below.

Respectfully submitted,



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Date: October 3, 2007

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Attorney Docket No. 28967.0178